

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant(s) R. K. Yang et al. Examiner: Michelle A. Lazor
Application No.: 10/074,272 Group Art Unit: 1734
Confirmation No: 4926 Docket: 1199-4 RCE
Filed: February 14, 2002 Dated: July 8, 2005
For: THIN FILM WITH NON-
SELF-AGGREGATING
UNIFORM HETERO-
GENEITY AND DRUG
DELIVERY SYSTEMS
MADE THEREFROM

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On: July 8, 2005*

Signature: K.J. Goodhand/ K. J. Goodhand

COMMUNICATION PURSUANT TO MPEP §819.01

Sir:

As permitted by MPEP §819.01, Applicants respectfully request a shift in inventions to change the elected species from claims directed to drying with a water-bath to claims directed to drying by application of hot air currents. The PTO agreed to this shift in inventions, as indicated in the Interview Summary dated June 1, 2005.

By way of explanation, the Examiner issued a first Restriction Requirement on July 2, 2004. In response, Applicants elected Group II, claims 23-31 and 51-55, which were drawn to a process for making film. Group II included generic claims, particularly claims 23-31 and 51-53, which were directed to a process of making film including the step of drying through

application of heat. Group II also included claims that more specifically were directed to drying the film with a heated water bath, particularly claims 54 and 55.

On December 20, 2004, the Examiner and the Supervisory Patent Examiner conducted a personal interview with Applicants' representatives and one of the named inventors. During the interview, only a set of proposed claims were addressed. The proposed claims were drawn to a process of making film, as in elected claim 23, including the step of drying the film by application of hot air currents. The proposed claims were discussed in detail in view of the prior art previously cited by the Examiner. At the conclusion of the interview, the Examiner provided Applicants' representatives with an Interview Summary, detailing the conclusions reached on the proposed claims.

Subsequently, Applicants' representatives and the Examiner discussed the proposed claims and suggested revisions thereof in view of newly discovered prior art provided by the Examiner. Once the revisions to the claims were finalized, Applicants submitted the proposed claims in the Amendment and Response dated March 29, 2005.

In the following Office Action, dated May 16, 2005, the Examiner issued a second Restriction Requirement, requiring an election of species between claims directed to drying with a water bath and claims directed to drying with hot air current. The Examiner stated that the water bath species were constructively elected and withdrew all claims drawn to the hot air currents species. The withdrawn claims, however, were those addressed in the personal interview and follow-up discussions with the Examiner. In view thereof, Applicants, as well as the Examiner, have invested a significant amount of time and effort into pursuing the claims drawn to drying with hot air currents. Pursuant to MPEP §819.01, therefore, Applicants respectfully request permission to shift inventions from claims directed to the water bath species to those drawn to the hot air currents species. Both species are encompassed by the generic, originally elected process claim.

As indicated in the Interview Summary dated June 1, 2005, the PTO agreed to this shift in inventions. In particular, the Supervisory Patent Examiner specifically stated that:

It was agreed that applicant could file claims in an RCE drawn to a generic drying step and other species of drying (including drying by air currents). These claims could be either independent or dependent. Applicants' representative was also told that upon receiving the RCE, a species different than [sic] that previously searched (i.e. drying by contact with a water bath) would be examined if presented. Applicants' representative was told that if multiple species (e.g. drying by hot air currents, drying by microwave, drying by IR radiation) are presented, these species are subject to restriction.

In accordance therewith, Applicants have concurrently filed a Request for Continued Examination. Applicants have reintroduced a generic drying claim therein. Applicants have voluntarily withdrawn all claims drawn to the water bath species in lieu of the claims drawn to the hot air currents species. The withdrawal of the water bath claims will simplify further examination. Additionally, Applicants have amended one of the previously presented claims to ensure that the only drying species present in the application is hot air currents. Therefore, Applicants have conformed with the recommendations of the PTO, delineated above.

In sum, Applicants respectfully request a shift in inventions pursuant to MPEP §819.01 to change the elected species, as described above.

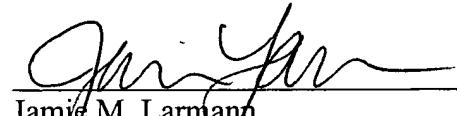
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If the Examiner has any questions regarding this Communication, she/he is encouraged to contact the undersigned attorney.

Respectfully submitted,



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